

R E M A R K S

This paper is being filed in response to an Office Action dated January 29, 2004. Claims 1-49 are currently pending in this application. The Examiner has withdrawn claims 30-49 from consideration.

Claims 1, 5, 8, 11, 14, 19, 22, and 27 have been amended by deleting the “so that . . .” phrases in both steps and by deleting the word “resulting” in the second step. These deletions further clarify the subject matter of the invention and are made in response to the Section 112, paragraph 2 rejections below. Applicants also respectfully submit that these amendments do not limit the scope of these claims. No new matter has been added by these deletions, because conducting the folds in either order is supported by the specification, *inter alia*, at p. 7, lines 3-14.

Claims 3, 6 and 12 have been amended to delete the word “that” for clarification according to the Examiner’s recommendation. No new matter has been added by this amendment.

Before addressing the rejections, Applicants would like to thank the Examiner for granting the telephonic interview held February 27, 2004. Applicants, Mark DeRaud and Adam Gabel, and their attorney, Samuel Lee, were present at the telephonic interview. The rejections and the asserted prior were discussed. It is Applicants’ understanding that agreement was reached for the Section 112 rejections based on the amendments presented herein.

The Restriction Requirement

The Examiner has made final the restriction of the claims pursuant to 35 U.S.C. § 121 to the following inventions:

- Group I: claims 1-29, drawn to a method of folding, classified in class 426, subclass 502;
- Group II: claims 30-42, drawn to a pizza product, classified in class 426, subclass 275; and
- Group III: claims 43-49, drawn to a shield, classified in class 99.

Applicants confirm with traversal their election of claims 1-29 for further prosecution on the merits. Claims 30-49 will be held in abeyance until agreement is reached on the elected claims.

Rejections under Section 112, Second Paragraph

Claims 1-29 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite. In particular, the Examiner finds unclear the terms/phrases “the top,” the “resulting slice” and “the tope of the resulting slice” in claims 1, 5, 8, 11, 14, 19, 22, and 27. Furthermore, the Examiner recommends deletion of the word “that” as unclear in claims 3, 6 and 12. In view of the amendments presented herein, Applicants respectfully submit that these rejections are not moot. Withdrawal of these rejections under Section 112, second paragraph, is respectfully requested.

Section 103 Rejections

Claims 1-13 have been rejected under 35 U.S.C. § 103(a) as unpatentable over the article on “Pizza Inversion” by Brad Appleton (“Appleton article”). The Examiner asserts that the Appleton article separately teaches (1) folding one half of a slice of pizza over the other half (“the half fold”) and (2) folding the pointed end of a slice of pizza towards the crust (“the End Fold”). (Appleton article, p. 4.) Although acknowledging the absence of any teaching or suggestion by the Appleton article to combine the two folds, e.g., folding the end portion and then folding one half over the other half, the Examiner asserts that it would have been obvious for the skilled artisan to apply the combined folds to obtain a closed pocket and prevent dripping of toppings and sauce.

Applicants respectfully traverse this rejection. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine references. Second, there must be a reasonable expectation of success. Lastly, the prior art reference, or references combined, must teach or suggest all the claim limitations. MPEP § 2143. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. See e.g., MPEP §2141 and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986).

First, as the Examiner acknowledges, the Appleton article fails to teach or suggest the combination of the two folds. In fact, the entire purpose of the Appleton article is to present a method to consume pizza slices quickly, while it is still hot, without burning a person’s mouth.

(See e.g., the paragraph under the subheading “Intent” at p. 1.) The Appleton article states in part:

When trying to eat pizza quickly, the grease on the cheese and the hot tomato sauce underneath can severely burn the roof of ones mouth. This is not only painful, but may also damage the taste buds in this sensitive region of the mouth, rendering them useless for a short duration.

The naïve approach of waiting for the pizza to cool may at first seem reasonable. But the resultant increase in the latency-time between when the pizza arrives and when it has cooled enough for human consumption imposes an unacceptable performance penalty that impedes programmer productivity.

Therefore, it is desirable to find a method for eating pizza quickly without burning one's mouth. At the same time, one still wants to experience the full splendor that comes from the taste and smell of a savory pizza fresh from the oven.

(Appleton article, pp. 1 and 2.) (Emphasis added.) The proposed solution is inverting one slice of pizza on top of another slice. (See e.g., p. 2 of the Appleton article.)

Thus, the Appleton article fails to even recognize the nature of the problem that is solved by the inventions of claims 1-13, e.g., a folding method that allows pizza to be eaten neatly with one hand and minimizes spillage of the toppings and sauce. (See p. 2, line 18-23 of the present application.) The Appleton article was merely written by a pizza enthusiast as a comic attempt to equate software development principles to eating pizza. It merely shows that it was known to eat pizza using either the Half Fold or the End Fold. Accordingly, the Appleton article fails to even recognize the problem to be solved and fails to provide any motivation or suggestion to combine the folds.

Second, Applicants also respectfully submit that the Examiner’s reliance of the Half Fold and the End Fold is misplaced, because the Appleton article actually teaches away from the presently claimed method. For example, at page 3 under the heading “Collaborations,” the Appleton article teaches that both “[h]ands bring both resulting PizzaSlices simultaneously toward Mouth.” Furthermore, at page 4 under the heading “Implementation,” The Appleton article cautions the reader away from using only a single slice by stating:

1. *Data Compression and Loss:* One needs to be extra careful when using a single slice and/or when the pizza has extra cheese because then excess cheese can easily ooze out the side and burn your mouth. In this case, use your Hands to press the

pieces (or halves) together to and detach the excess Cheese, Toppings, and Sauce, before inserting into Mouth.

These recited portions of the Appleton article evidences recognition of at least one problem addressed by the claimed method, e.g., the need to encapsulate the sauce and toppings, but still fails to arrive at the presently claimed method. In fact, this article was published as early as 1995 and is still currently available on the internet. However, even after nine years, no one has suggested combining the End Fold and the Half Fold to a slice of pizza, as the Examiner asserts.

Third, Applicants respectfully submit that the Examiner has not met her burden to show that the motivation or desirability to modify the two separate folds in the Appleton article was within the knowledge of the skilled artisan. The Examiner has not presented any evidence of the use of the combined folds for a pizza slice that is at least partially baked. In fact, the major pizza companies in the industry have failed to teach or suggest the combined folds for a pizza slice, despite the unmet need of selling pizza configured to be eaten neatly with one hand. Furthermore, it would not have been obvious to the skilled artisan to apply the combined folds to a pizza slice. Not only is the combination of the two folds counter-intuitive, the skilled artisan would expect the traditionally flat pizza slice to be thickened and stiffened by one fold and to resist a second fold.

Without any motivation or desirability to combine the separately disclosed Half Fold and the End Fold in the Appleton article, the Examiner is using impermissible hindsight vision afforded by the claimed invention. The fact that aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *See e.g.*, MPEP 2143.01, especially the subsection title “Fact that the Claimed Invention is within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish Prima Facie Obviousness.” Applicants, therefore, respectfully request withdrawal of this Section 103(a) rejection of claims 1-13.

Claims 14-29 have been rejected under 35 U.S.C. § 103(a) as unpatentable over the Appleton article in view of p. 447 of the cookbook titled “Cooking A to Z” (“the Cookbook”). The Examiner points to the Appleton article for separately teaching (1) folding one half of a slice of pizza over the other half and (2) folding the pointed end of a slice of pizza towards the crust. (Appleton article, p. 4.) The Examiner points to page 447 of the Cookbook as showing a pizza slice having one end substantially free of toppings. Although acknowledging the absence of any

teaching or suggestion by the Appleton article to combine to two folds, e.g., folding the end portion and then folding one half over the other half, the Examiner asserts that it would have been obvious for the skilled artisan to apply the combined folds to obtain a closed pocket and prevent dripping of toppings and sauce. The Examiner further asserts that it would have been obvious to make a pizza without any toppings at one end as purportedly as shown in p. 447 of the Cookbook, because pizza is a very versatile food product.

Applicants respectfully traverse this rejection. Applicants respectfully submit that p. 447 of the Cookbook does not even address, much less resolve, the deficiencies in the Appleton article. Page 447 of the Cookbook seems to show a whole pizza with at least one topping, i.e., cheese, throughout the entire surface of the pizza. The slice of the pizza on p. 447 of the Cookbook, therefore, is not substantially free of toppings. (*See e.g.*, p. 6, lines 8-12 of the Applicants' specification, which includes cheese as a topping.) Applicants also incorporate by reference the arguments presented above for this rejection of claims 14-29, because the combination of the Appleton article and p. 447 of the Cookbook also fails to teach or suggest the combination of the Half Fold and the End Fold for a pizza slice. Accordingly, withdrawal of this Section 103 rejection of claims 14-29 is respectfully requested.

Conclusion

In view of the remarks provided above, applicants submit that the present application is in condition for allowance. Reconsideration and allowance is respectfully requested.

Respectfully submitted,

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